

Remarks

Claims 1-14 are pending. Claims 1-7 have been rejected, although claim 6 has not been rejected over prior art. Applicants request, as an initial matter, that claim 6 be deemed allowable as any § 112 rejections have been rendered moot, as discussed below.

Claims 8-14 have been added. Claims 8-14 are analogous to claims 1-7, but recite a conductive layer formed on the flexible support body. Support for claims 8-14 can be found, for example, on page 14, line 20 to page 15, line 10.

Independent claim 1 has been amended to recite a belt-type photosensitive body with a conductive support body.

I. Objections to the Abstract

The Examiner has objected to various informalities in the Abstract. Please replace the present Abstract with the amended abstract enclosed herewith.

II. Statement Regarding Mean-Plus-Function Limitation

The Examiner has indicated parts of the Specification that provide "means for electrophotography". The Examiner suggest that "the only definition of such means is provided by instant Fig. 3 and equivalents thereof" (see page 3 of the Office Action dated 2/28/2003). Contradicting the above statement, however, the Examiner further notes the Specification at page 31, lines 17-22 as providing a description of "means for electrophotography". Applicants note that the description of such means on page 31 further includes lines 2-16.

Applicants further note that additional description of "means for electrophotography" can be found (both express and inherent) throughout the Specification as it relates to the photosensitive body of the present invention. Examples of such description can be found, but is not limited to, page 11, lines 19-25, and page 12 lines 1-12.

The Examiner is requested to acknowledge that additional description of means for electrophotography can be found in the application, as set forth above.

III. Rejections Under § 112, second paragraph -- claims 3 and 4

The Examiner has rejected claims 3 and 4 due to the allegedly indefinite phrase "bisphenol z-type polycarbonate resin". Claims 3 and 4 have been amended to recite, and newly added claims 10 and 11 recite, a bisphenol Z polycarbonate resin.

IV. Rejections under § 112, second paragraph -- Claims 1-7

The Examiner has rejected claims 1-7 under § 112, second paragraph, as being "incomplete for omitting essential elements" (*See*, page 4 of Office Action dated February, 28, 2003, paragraph 5). The Examiner alleges that a conductive substrate is an essential element.

Applicants note that there is no "essential element" test under current U.S. patent law, as articulated by the Federal Circuit. *See, e.g., Amgen, Inc. v. Hoechst Marion Roussel Inc.*, 65 USPQ2d 1385, 1388-89 (Fed. Cir. 2003) (rejecting argument that patentee must incorporate essential elements into the claims). Nevertheless, solely to advance prosecution, Applicants have amended claim 1 to recite a conductive flexible support body. Newly added independent Claim 8 recites a flexible support body having a conductive layer formed thereon.

IV. Rejections under § 112, first paragraph -- Claims 1-7

The Examiner has also rejected claims 1-7 under § 112, first paragraph. The Examiner essentially relies on the essential element theory advanced above. Applicants submit that the *specification* does indeed satisfy the written description and enablement requirements of § 112, first paragraph, and that § 112, as interpreted in accordance with current Federal Circuit precedent, does not have any "essential element" requirement. *Amgen, Inc.*, 65 USPQ2d at 1388-89. Nevertheless, the amendment to claim 1, discussed above, have rendered this rejection moot.

V. Rejections under § 103(a) -- Claims 1-4

Claims 1-4 stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Pat. No. 5,629,117 (Katsukawa), in view of Diamond, Handbook of Imaging Materials (Diamond) and U.S. Pat. No. 5,737,669 (Ring). The Examiner admits "Katsukawa does not exemplify the use of an endless flexible substrate as recited in the instant claims", ie. a flexible support body. The Examiner suggest, however, that it would be obvious to substitute the aluminum tube substrate of Katsukawa for a flexible support body, given that Katsukawa does not limit the substrate to an aluminum tube, that Diamond mentions the mere possibility of an endless belt, and that Ring mentions an endless belt stretched over rollers to overcome the high costs of using drums as substrates.

Whereas the present invention provides a belt-type photosensitive body, Katsukawa discloses embodiments of an electrophotosensitive material applied to a aluminum tube substrate (Katsukawa, col. 28, ll. 49-50). Although Katsukawa mentions, only in passing, that a substrate may be in the form of a sheet, Katsukawa also stresses the importance of the mechanical strength of the substrate (Katsukawa, col. 26, lines 35-36), and does not disclose

embodiments teaching use of a flexible support body as presently claimed. Furthermore, in Katsukawa's examples, metal-free phthalocyanines are primarily employed (See, e.g., Katsukawa, Examples 320-326, 328-334, 336-342, 344-350, 352-358).

A person of ordinary skill in the art is not motivated to combine Diamond and Ring with Katsukawa to obtain the flexible support body of the photosensitive body of the present invention. Missing from Diamond and Ring is any motivation to use the *particular* agents used in the photosensitive layer of Katsukawa on the flexible support body of present invention. The present invention recites use of a titanyl phthalocyanine as the charge generating agent, and polycarbonate as the resin. Diamond provides no teaching or suggestion as to the specifics of the photosensitive layer. Likewise, Ring concerns the printer itself, and only generally refers to an endless photoreceptive image carrying ribbon. Because the secondary references do not provide guidance as to the particular agents to be used in the photosensitive body, a person of ordinary skill would not consult these references to improve upon the drum-type photosensitive body exemplified in Katsukawa.

A person of ordinary skill would likewise be unable to derive the present invention from Katsukawa itself. Katsukawa discloses 17 possible charge generating materials (Katsukawa, col. 23, lines 51-64). The skilled artisan is provided no guidance as to which of these 17 possible charge generating materials should be selected for use on a flexible support body, as this non-exemplified substrate is only mentioned in passing in Katsukawa. Only with the impermissible use of hindsight is a person of ordinary skill able to arrive at the present invention.

In view of the actions taken and arguments made, it is believed that the above-referenced obviousness rejection has been overcome. It is respectfully requested that the rejection be withdrawn.

VI. Rejections under § 103(a) -- Claims 1, 5, and 7

Claims 1, 5 and 7 stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Pat. No. 6,198,889 (Yu), in view of European Patent 574,154 (EP '154). Yu is not directed towards a photosensitive body, *per se*, instead providing a process for continuous slow speed cycling of a flexible imaging belt to eliminate the undesirable impacts of belt-parking. The Examiner admits that Yu does not exemplify a single photosensitive layer as recited in independent claim 1. EP '154 does provide a single photosensitive layer, but the disclosure refers to use of an ordinary aluminum tube as a substrate (EP '154 page 6, line 42).

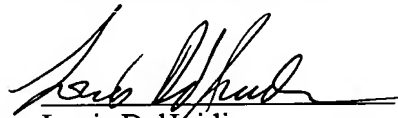
A person of ordinary skill in the art would not be motivated to combine Yu and EP '154 to obtain the photosensitive body of the present invention. As mentioned above, EP '154 envisions use of "an ordinary aluminum tube" and the examples teach use of aluminum foil as the conductive substrate to measure the reduction potential (EP '154, page 10, lines 27). A belt-type photosensitive body is not disclosed in EP '154. In contrast, Yu's "improved belt cycling system" does not mention use of drum-type substrates, and exclusively uses belt-type photosensitive bodies. Thus, the Examiner requires the person of ordinary skill to combine a reference teaching the drum-type photosensitive body of EP' 154, with a process (Yu) that exclusively uses belt-type photosensitive bodies. Without the impermissible use of hindsight, the person of ordinary skill would not be motivated to combine these two divergent photosensitive bodies, and a *prima facie* case of obviousness has not been established.

In view of the actions taken and arguments made, it is believed that the above-referenced obviousness rejection has been overcome. It is respectfully requested that the rejection be withdrawn.

V. Conclusion

In view of the foregoing, it is believed that all pending claims are in condition for allowance. It is respectfully requested that the pending claims be allowed. Favorable action is earnestly solicited.

Respectfully submitted,



Louis Del Giudice
Reg. No. 47,522
Attorney for Applicants

DARBY & DARBY P.C.
P.O. Box 5257
New York, New York 10022-7557
(212) 527-7700